THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ALBERT J. JEHLE

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Appeal No. 96-0957
Application 08/138,359[1]

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ON BRIEF

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Before MEISTER, STAAB and CRAWFORD, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

[1] Application for patent filed October 18, 1993.

DECISION ON APPEAL

Albert J. Jehle (the appellant) appeals from the final rejection of claims 1, 6-11 and 23-27, the only claims remaining in the application. We reverse.

The appellant's invention pertains to a hypodermic needle assembly. Independent claim 24 is further illustrative of the appealed subject matter and reads as follows:

24. A hypodermic needle assembly comprising:

means providing a tube having a wall with a cylindrical inner surface having a central axis, and having first and second openings at opposite ends thereof; and

a piston having first and second opposite faces, with a hollow needle extending from the first face, a fitting on the second face for disconnectible, fluid-tight attachment to a syringe, and means providing a passage within the piston for fluid communication between the needle and the fitting, the piston being located within the tube and frictionally engaging the cylindrical inner surface of the wall of the tube but being axially slidable therein when subjected to an external force, the piston being engaged with the cylindrical inner surface at least at two axially spaced locations whereby the needle is held substantially parallel to the central axis of the cylindrical inner surface of the wall of the tube as the piston slides along the axis, the needle and piston being locatable entirely within the tube, and axially movable to a position in which the needle extends outward from the first opening of the tube while the piston is inside the tube;

wherein the wall of the tube has portions which are compressible inwardly against the piston by manual pressure

exerted on the exterior of the tube while the inner surface of the other portions of the wall remains cylindrical, to prevent the piston from rotating relative to the tube both when the piston is located so that the needle extends outwardly from the first opening and when the piston is located so that the needle is located entirely within the tube.

The references relied on by the examiner are:

Quaas	4,295,476	Oct. 20, 1981
Wilkins	5,137,521	Aug. 11, 1992
Feeney, Jr. (Feeney)	5,267,977	Dec. 7, 1993

Claims 1, 6-8, 10, 11 and 23-27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Feeney in view of Quaas.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Feeney in view of Quaas and Wilkins.

The examiner's rejections are explained on pages 4 and 5 of the answer. The arguments of the appellant and the examiner in support of their respective positions are found on pages 3-12 of the brief and pages 6-9 of the answer.

OPINION

As a preliminary matter, we based our understanding of the appealed subject matter upon the following interpretation of the terminology appearing in the claims. In line 2 of claim 25[2] we interpret "said flexible portions" to be -- said compressible portions --. In line 29 of claim 26 we interpret "the flexible means" to be -- the flexible portion --.

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and by the examiner in the answer. This review leads us to conclude that the prior art relied on by the examiner fails to establish the obviousness of the subject matter defined by the claims on appeal.

According to the examiner, it would have been obvious "to include the holding means disclosed in Quaas in the invention disclosed in Feeney" (see answer, page 5). In support of this position the answer states that

> Feeney, Jr. and Quaas are concerned with preventing unintended movement in a needle

[2] Reference to specific lines in the claims in this opinion is with respect to the claims as they appear in the appendix to the appellant's brief.

> assembly/syringe. The purpose of the lock/holding means (26) disclosed in Quaas is to prevent any movement of the blood container. The purpose of the lock/holding means (22, 24, 26, 28) in Feeney, Jr. is to prevent any movement of the needle (18). One of ordinary skill in the art would find it obvious to exchange one type of lock/holding means for another where the locks/holding means are directed to preventing movement in a syringe or needle assembly. (See Quaas, column 3, lines 12-41.) [Pages 7 and 8.]

We do not agree with the examiner's position. The mere fact that, as a broad proposition, both Feeney and Quaas disclose a locking/holding means does not serve as a proper basis for concluding that it would been obvious to substitute in Feeney for his locking/holding means the locking/holding means of Quaas. Instead, it is the teachings of the prior art which must provide the motivation or suggestion to combine the references. ***See, e.g., In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Here, we find no such suggestion.

Feeney discloses a tube 16 which functions as a protective sheath, a piston 14, a needle 18 mounted on one end of the piston, a means for affixing the barrel 12 of a syringe mounted on the other end of the piston (see column 3, line 5) and a locking/holding means in the form of buttons 22 on the outer surface of the piston which interact with (1) "rails" or grooves

24 and (2) locking chambers 26 located on one end of the grooves. The stated function of Feeney's rails is to limit the travel of the piston relative to the tube (see column 3, lines 1-5) while the locking chambers, by virtue of the fact that the buttons may be forced or snapped into and out of these chambers, function to releasably retain the piston in a position wherein the needle is

located inside of the tube. Moreover, as stated on page 5 of the brief, a self-evident purpose of Feeney's rails and buttons is that:

> The engagement of the buttons with the rails inherently prevents the hub from rotating, and therefore, the syringe barrel can be attached to, and detached from, the hub.

On the other hand, Quaas is directed to a blood collecting device which includes (1) a generally tubular, air-evacuated blood collection container 35 having an otherwise open end that is closed with a needle-penetrable closure 36 and (2) a generally cylindrical receptacle 12 having an open end and a closed end, with a double ended needle cannula fixed to the closed end in such a manner that one needle 20 protrudes therefrom and the other needle 22 (which is covered by a resilient valve sheath 25) is received within the receptacle 12.

In use, the protruding needle 20 is inserted into the vein of a patient and the end of the blood collection container 35 having the penetrable closure 36 thereon is inserted into the receptacle 12 until the needle 22 penetrates the penetrable closure and the resilient valve sheath 25 is compressed. The cylindrical wall of the receptacle 12 is also provided with a locking/holding means in the form of an inwardly depressible tongue 26 that engages a

lip 38 which is formed on the closure 36 for the stated purpose of (1) preventing the blood collection container 35 from being pushed out of the receptacle 12 by the "spring force" of the compressed valve sheath (column 3, lines 1-6), (2) insuring that there is an "uninterrupted blood draw" (column 3, lines 22 and 23) and (3) preventing injury to the patient by eliminating the "constant inward pushing" of the blood collection container 35 (column 3, lines 35-40).

Thus, while both Feeney and Quaas both as a broad proposition disclose a locking/holding means, they function in an entirely different manner and are used in completely different types of devices. Absent the appellant's own teachings, we can think of no cogent reason why one of ordinary

skill in this art would have been motivated to seek out the disparate locking/holding means of Quaas and incorporate it into the device of Feeney in the manner proposed by the examiner (i.e., by substituting the locking/holding means of Quaas for the locking/holding means of Feeney). Indeed, if such a substitution of locking/holding means were made, Feeney's intended function of limiting travel of his piston (and, hence, his needle) in both directions would apparently be destroyed. ***Cf. Ex parte Hartmann***, 186 USPQ 366, 367 (Bd. App. 1974).

With respect to the rejection of claim 9 under 35 U.S.C. § 103 based on the combined teachings of Feeney, Quaas and Wilkins, we have carefully reviewed the teachings of Wilkins but find nothing therein which would overcome the above-noted deficiencies of Feeney and Quaas.

In view of the foregoing the examiner's rejections of claims 1, 6-11 and 23-27 under 35 U.S.C. § 103 are reversed.

REVERSED

JAMES M. MEISTER)
Administrative Patent Judge)
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	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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